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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,367	03/07/2002	Baldomero M. Olivera	2314-224-11	7797

6449 7590 10/07/2003

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EXAMINER	
KAM, CHIH MIN	

ART UNIT	PAPER NUMBER
1653	

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/092,367	OLIVERA ET AL.	
	Examin r	Art Unit	
	Chih-Min Kam	1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-24* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U. S. C. 121:

I. Claims 1, 2 and 5, drawn to a conotoxin peptide, a derivative thereof or a conopeptide propeptide having an amino acid sequence set forth in Table 4, classified in class 514, subclass 2, and class 530, subclass 300.

II. Claims 3 and 4, drawn to an isolated nucleic acid encoding a conopeptide propeptide set forth in Table 4, classified in class 536, subclass 23.1.

III. Claims 6-23, drawn to a method of treating or preventing disorders associated with excessive excitation of nerve cells, or treating memory or cognitive deficits, HIV infection or ophthalmic indications by administering to a patient a conotoxin peptide, classified in class 514, subclass 2, and class 424, subclass 9.1.

IV. Claim 24, drawn to a method of controlling nematodes or parasitic worms by applying a conotoxin peptide to the locus to be protected, classified in class 514, subclass 2, and class 424, subclass 9.1.

Should Group I be elected, applicant is required to select one conotoxin peptide from claim 1 and the corresponding propeptide from Table 4, where each conotoxin or propeptide sequence should be identified with a "SEQ ID NO:". Each polypeptide, which contains different amino acid sequence, exhibits different chemical and physical properties and has different effect, is patentably distinct. This is not species election.

Should Group II be elected, applicant is required to select one nucleotide sequence from Table 4 identified with a "SEQ ID NO:". Each nucleotide sequence, absent factual data to the contrary, is patentably distinct. This is not species election.

Should Group III be elected, applicant is required to select one conotoxin peptide from claim 1 identified with a "SEQ ID NO:", and one specific disease from claims 9, 11, 13, 15, 17, 19, 21 and 23. Should Group IV be elected, applicant is required to select one conotoxin peptide from claim 1 identified with a "SEQ ID NO:". Each polypeptide, which contains different amino acid sequence, exhibits different chemical and physical properties and has different effect, is patentably distinct; and each disease, where the diagnosis is different and which has different treatment and outcome, is considered patentably distinct. This is not species election.

2. The inventions are distinct, each from the other because of the following reasons:

The peptide of Invention I is related to nucleotide of Invention II because the peptide can be produced by the expression of nucleotide in the cell. The inventions are distinct because they are physically and functionally distinct chemical entities and the peptide can be made by another process such as solid phase peptide synthesis.

The product of Invention I and the methods of Inventions III and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the methods of Inventions III and IV are alternative processes of use of the product of Invention I.

The product of Invention II is distinct from the methods of Inventions III and IV because the product of Invention II can be neither made by nor used in the methods of Inventions III and IV.

The methods of Inventions III and IV are distinct from each other because the method steps and outcomes are wholly different among Inventions III and IV.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, and because inventions I-IV require different searches but are not co-extensive, examination of these distinct inventions would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

A telephone call was made to Jeffrey Ihnen on October 5, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, Ph. D. can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D. CMK
Patent Examiner

Christopher Low

October 5, 2003

CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600